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| 10/595,132 | 03/02/2006 | Bo Ekstrom | P18082-US1 | 3246 |
| 27045 | 7590 | 05/11/2010 | EXAMINER | |
| ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024 | | | MASUR, PAUL H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2464 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/595,132 | Applicant(s) EKSTROM ET AL. | |
| | Examiner Paul Masur | Art Unit 2464 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 13 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12, 14-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. **Applicant's arguments filed 01/28/2010 have been fully considered but they are not persuasive.**
2. **On pages 6 and 7 of the remarks, in regard to claim 12**, the applicant submits that Cope fails to teach or anticipate each and every limitation as disclosed in the claim language. Specifically, the applicant points to Cope's failure in regard to the limitation *"including the step of sending an indicator from the control domain to the bearer domain indicating that the media flow involves the first subscriber is to be monitored"*. The applicant alleges that the cited portions of Cope (Figure 4, block 76, column 8, lines 43-49) fail to teach this limitation. Lastly, the applicant submits that an electronic search of the reference has yielded no mention of the terms *"control"*, *"bearer"*, or *"domain"*.

The examiner respectfully disagrees. While the examiner does acknowledge that the terms noted by the applicant do not appear after an electronic search of the reference, the examiner notes that the reference does contain these limitations. The discrepancy lies in the nomenclature for these terms. Specifically, Figure 3 of the reference (which is directed to the same embodiment as Figure 4), discloses two parts to the signaling in the reference. There is a signaling plane for voice communications [column 8, lines 16-30] and communication set up messages [column 6, lines 48-53]. Under the broadest reasonable interpretation, these correlate to the control and bearer domains respectively. The reference teaches call setup messages, or a control domain, since the reference discloses SS7 or DTMF digits to perform these tasks. According to

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these teachings, the examiner believes that within the voice calls made that are to be monitored, there is a signaling (or control) component separate from the voice (bearer) component.

3. **On pages 7 and 8 of the remarks, in regard to claims 14-16 and 18-22,** the applicant submit that for at least the reasons that Cope does not anticipate claim 12, it also fails to anticipate similar independent claims and their associated dependent claims. This is asserted in relation to independent claims 15 and 20, as well as dependent claims 14, 16, 18, 19, 21, 22, and 23.

The examiner respectfully disagrees. The examiner kindly directs the applicant to the arguments listed above.

Claim Rejections - 35 USC § 102

4. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office**

action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 12, 14-16, and 18-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Cope et al. (US Patent No. 7,055,174).**

6. **As per claim 12**, Cope et al. teach a method for monitoring media flow in a telecommunication network having a control domain for handling session control and a bearer domain for handling media flow, comprising the steps of:

storing, in a database in the control domain, identification of a first subscriber for which monitoring is desired [Cope, fig. 4, block 74, column 8, lines 31-35, "According to the exemplary embodiment, at block 74, an entity that is involved with initiating or maintaining the communication session (or any other entity for that matter) may also programmatically determine that the subject is under surveillance. In the present example, that entity may be session manager 26", The session manager stores the identification of a subscriber to monitor.];

setting up a connection between the first subscriber and a second subscriber [Cope, fig, 4, block 72, column 8, lines 16-30, "gateway 16 may thus receive an origination request and responsively signal to session manager 26 for handling instructions. After negotiating with remote session manager 28, session manager 26 may then instruct gateway 16 to route the packets of the voice communication via a particular port associated with remote gateway 22, and gateway 16 may route the packets to their intended destination (e.g., remote gateway 22) as instructed. Through this conventional call setup and connection process, packets representing a communication from station 12 to station 18 may pass from gateway 16 to gateway 22, and packets representing communication from station 18 to station 12 would pass from gateway 22 to gateway 16, thereby facilitating two-way end-to-end communication between stations 12 and 18", The connection is set up between the subscribers.],

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including the step of sending an indicator from the control domain to the bearer domain indicating that the media flow that involves the first subscriber is to be monitored [Cope, fig. 4, block 76, column 8, lines 43-49, "session manager 26 may programmatically send a wiretap-message to controller 44, advising the controller that a session involving the subject is being established and providing the controller with an indication of two ports (linkpoints) in gateway 16 that are associated with ISH 46 (i.e., ports by which gateway 16 can route packets to ISH 46)", The session manager sends a control domain message that monitoring is desired for a particular subscriber.];

re-routing said media flow between the subscribers via a server function in the bearer domain [Cope, fig. 4, blocks 82 & 84, column 9, lines 1-9, "at block 82, controller 44 may responsively send a call-setup message to circuit-switch 48, instructing the switch to set up a call path between ISH 46 and law enforcement agency 42 (or simply to set up a call path from the switch to the law enforcement agency). In the exemplary embodiment, the call-setup message can be a conventional ISUP message, such as an initial address message ("IAM") for instance. In response, at block 84, switch 48 may set up the call path as directed", The path is re-routed through the monitoring device within the network.], the server function at a fixed location that is independent from a change of location of the subscribers involved in the media flow [Cope, column 4, lines 16-19, fig. 1, element 12, "first and second subscriber stations 12, 18 may each take various forms. By way of example, either or each of the subscriber stations may be a landline or wireless telephone", The subscriber stations can be mobile phones, so the method enclosed works no matter their location.]; and,

monitoring the media flow that passes the server function [Cope, fig. 3, element 42, column 8, lines 18-20, "controller 44 may be coupled by a transmission line 62 or other communications link to law enforcement agency 42 or other observer", Re-routed communications are observed by law enforcement.].

7. **As per claim 14**, Cope et al. teach the method for monitoring media flow in a telecommunication network according to claim 12. Cope et al. also teach further comprising the step of sending an address to the server function from the control domain to the bearer domain [Cope, fig. 4, block 76, column 8, lines 43-49, "session manager 26 may programmatically send a wiretap-message to controller 44, advising the controller that a session involving the subject is being established and providing the controller with an indication of two ports (linkpoints) in gateway 16 that are associated with ISH 46 (i.e., ports by which gateway 16 can route packets to ISH 46)", The session manager sends a control domain message that monitoring is desired for a particular subscriber.].

8. **As per claim 15**, Cope et al. teach a method for monitoring media flow in a telecommunication network having a control domain and a bearer domain, wherein session control is handled in the control domain and media flow is handled in the bearer domain, comprising the steps of:

storing, in a database in the control domain, identification of a first subscriber for which monitoring is desired [Cope, fig. 4, block 74, column 8, lines 31-35, "According to the exemplary embodiment, at block 74, an entity that is involved with initiating or maintaining the communication session (or any other entity for that matter) may also

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programmatically determine that the subject is under surveillance. In the present example, that entity may be session manager 26", The session manager stores the identification of a subscriber to monitor.];

setting up a connection between the first subscriber and a second subscriber [Cope, fig, 4, block 72, column 8, lines 16-30, "gateway 16 may thus receive an origination request and responsively signal to session manager 26 for handling instructions. After negotiating with remote session manager 28, session manager 26 may then instruct gateway 16 to route the packets of the voice communication via a particular port associated with remote gateway 22, and gateway 16 may route the packets to their intended destination (e.g., remote gateway 22) as instructed. Through this conventional call setup and connection process, packets representing a communication from station 12 to station 18 may pass from gateway 16 to gateway 22, and packets representing communication from station 18 to station 12 would pass from gateway 22 to gateway 16, thereby facilitating two-way end-to-end communication between stations 12 and 18", The connection is set up between the subscribers.], including the step of sending an indicator from the control domain to the bearer domain indicating that the media flow that involves the first subscriber is to be monitored [Cope, fig. 4, block 76, column 8, lines 43-49, "session manager 26 may programmatically send a wiretap-message to controller 44, advising the controller that a session involving the subject is being established and providing the controller with an indication of two ports (linkpoints) in gateway 16 that are associated with ISH 46 (i.e., ports by which gateway

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16 can route packets to ISH 46)", The session manager sends a control domain message that monitoring is desired for a particular subscriber.];

re-routing a media flow between the subscribers for which monitoring is desired via a server function in the bearer domain, the server function at a fixed location [Cope, fig. 4, blocks 82 & 84, column 9, lines 1-9, "at block 82, controller 44 may responsively send a call-setup message to circuit-switch 48, instructing the switch to set up a call path between ISH 46 and law enforcement agency 42 (or simply to set up a call path from the switch to the law enforcement agency). In the exemplary embodiment, the call-setup message can be a conventional ISUP message, such as an initial address message ("IAM") for instance. In response, at block 84, switch 48 may set up the call path as directed", The path is re-routed through the monitoring device within the network.], that is independent from a change of location of the subscribers involved in the media flow [Cope, column 4, lines 16-19, fig. 1, element 12, "first and second subscriber stations 12, 18 may each take various forms. By way of example, either or each of the subscriber stations may be a landline or wireless telephone", The subscriber stations can be mobile phones, so the method enclosed works no matter their location.]; and,

monitoring the media flow when it passes the server function at the fixed location [Cope, fig. 3, element 42, column 8, lines 18-20, "controller 44 may be coupled by a transmission line 62 or other communications link to law enforcement agency 42 or other observer", Re-routed communications are observed by law enforcement.].

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9. **As per claim 16**, Cope et al. teach the method for monitoring media flow in a telecommunication network according to claim 15. Cope et al. also teach further comprising the steps of: sending an address to the server function from the control domain to the bearer domain [Cope, fig. 4, block 76, column 8, lines 43-49, "session manager 26 may programmatically send a wiretap-message to controller 44, advising the controller that a session involving the subject is being established and providing the controller with an indication of two ports (linkpoints) in gateway 16 that are associated with ISH 46 (i.e., ports by which gateway 16 can route packets to ISH 46)", The session manager sends a control domain message that monitoring is desired for a particular subscriber.].

10. **As per claim 19**, Cope et al. teach the method for monitoring media flow in a telecommunication network according to claims 15. Cope et al. also teach further comprising the step of exchanging an address to the dedicated server function with a pseudo address in order to hide the re-routing of the media flow via the server function from the first and second subscribers [Cope, column 3, lines 22-27, "the circuit-switch may decode at least one DTMF digit from within the voice communication and output a signal representative of the at least one DTMF digit. A signal representative of the at least one DTMF digit may then be output (e.g., by the wiretap server) for receipt by the observer", The DTMF digits are masked before they reach the subscriber.].

11. **As per claim 18**, Cope et al. teach the method for monitoring media flow in a telecommunication network according to claim 15. Cope et al. also teach further comprising the step of setting up a three-part conference between the first and second

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subscribers and a distribution function, wherein the distribution function is a listener only function [Cope, fig. 3, element 42, column 8, lines 18-20, “controller 44 may be coupled by a transmission line 62 or other communications link to law enforcement agency 42 or other observer”, Re-routed communications are observed by law enforcement.].

12. **As per claim 20**, Cope et al. teach a system to monitor media flow in a telecommunication network having a control domain for handling session control and a bearer domain for handling media flow, comprising:

means for storing, in a database in the control domain, identification of a first subscriber for which monitoring is desired [Cope, fig. 4, block 74, column 8, lines 31-35, “According to the exemplary embodiment, at block 74, an entity that is involved with initiating or maintaining the communication session (or any other entity for that matter) may also programmatically determine that the subject is under surveillance. In the present example, that entity may be session manager 26”, The session manager stores the identification of a subscriber to monitor.];

means for setting up a connection between the first subscriber and a second subscriber [Cope, fig. 4, block 72, column 8, lines 16-30, “gateway 16 may thus receive an origination request and responsively signal to session manager 26 for handling instructions. After negotiating with remote session manager 28, session manager 26 may then instruct gateway 16 to route the packets of the voice communication via a particular port associated with remote gateway 22, and gateway 16 may route the packets to their intended destination (e.g., remote gateway 22) as instructed. Through this conventional call setup and connection process, packets representing a

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communication from station 12 to station 18 may pass from gateway 16 to gateway 22, and packets representing communication from station 18 to station 12 would pass from gateway 22 to gateway 16, thereby facilitating two-way end-to-end communication between stations 12 and 18", The connection is set up between the subscribers.];

means for sending an indicator from the control domain to the bearer domain indicating that a media flow that involves the first subscriber is to be monitored [Cope, fig. 4, block 76, column 8, lines 43-49, "session manager 26 may programmatically send a wiretap-message to controller 44, advising the controller that a session involving the subject is being established and providing the controller with an indication of two ports (linkpoints) in gateway 16 that are associated with ISH 46 (i.e., ports by which gateway 16 can route packets to ISH 46)", The session manager sends a control domain message that monitoring is desired for a particular subscriber.];

means for re-routing the media flow between the subscribers via a server function in the bearer domain [Cope, fig. 4, blocks 82 & 84, column 9, lines 1-9, "at block 82, controller 44 may responsively send a call-setup message to circuit-switch 48, instructing the switch to set up a call path between ISH 46 and law enforcement agency 42 (or simply to set up a call path from the switch to the law enforcement agency). In the exemplary embodiment, the call-setup message can be a conventional ISUP message, such as an initial address message ("IAM") for instance. In response, at block 84, switch 48 may set up the call path as directed", The path is re-routed through the monitoring device within the network.], the server function at a fixed location that is independent from a change of location of the subscribers involved in the media flow

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[Cope, column 4, lines 16-19, fig. 1, element 12, "first and second subscriber stations 12, 18 may each take various forms. By way of example, either or each of the subscriber stations may be a landline or wireless telephone", The subscriber stations can be mobile phones, so the method enclosed works no matter their location.]; and,

means for monitoring the media flow that passes the server function at the fixed location [Cope, fig. 3, element 42, column 8, lines 18-20, "controller 44 may be coupled by a transmission line 62 or other communications link to law enforcement agency 42 or other observer", Re-routed communications are observed by law enforcement.].

13. **As per claim 21**, Cope et al. teach the system to monitor media flow in a telecommunication network according to claim 20. Cope et al. also teach further comprising means for setting up a three-part conference between the first and second subscribers and a distribution function, wherein the distribution function is a listener only function [Cope, fig. 3, element 42, column 8, lines 18-20, "controller 44 may be coupled by a transmission line 62 or other communications link to law enforcement agency 42 or other observer", Re-routed communications are observed by law enforcement.].

14. **As per claim 22**, Cope et al. teach the system to monitor media flow in a telecommunication network according to claim 20. Cope et al. also teach further comprising means for exchanging an address to the server function with a pseudo address in order to hide the re-routing of the media flow via the server function from the first and second subscribers [Cope, column 3, lines 22-27, "the circuit-switch may decode at least one DTMF digit from within the voice communication and output a signal representative of the at least one DTMF digit. A signal representative of the at

least one DTMF digit may then be output (e.g., by the wiretap server) for receipt by the observer”, The DTMF digits are masked before they reach the subscriber.].

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. **The Examiner has cited particular columns and line numbers or paragraphs in the references applied to the claims above for the convenience of the applicant.** Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, the Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

17. If the Applicant is of the opinion that an interview would help advance prosecution in this case, they are welcome to call the Examiner, Paul Masur, at the number listed below to schedule an interview. The Examiner prefers interview requests be accompanied with a detailed agenda via fax. The Examiner's fax number is (571) 270-8297. The Examiner is willing to consider proposed amendments, clarify rejections, and discuss any other issues that are presented by the Applicant. Please note that the Examiner may not be able to accommodate all requests due to scheduling constraints. It is recommended that interview requests be sent with ample time to schedule an interview.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Masur whose telephone number is (571) 270-7297. The examiner can normally be reached on Monday through Friday from 7:00AM to 4:30PM (Eastern Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ricky Ngo/
Supervisory Patent Examiner, Art Unit 2464

/P. M./
Examiner, Art Unit 2464